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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/749,654

12/31/2003

Robert B. Staszewski

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

PHU, PHUONG M

ART UNIT

PAPER NUMBER

2611

NOTIFICATION DATE

DELIVERY MODE

04/10/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@ti.com

Office Action Summary	Application No. 10/749,654	Applicant(s) STASZEWSKI ET AL.	
	Examiner Phuong Phu	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 16, 19, 20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-11, 16, 19, 20, 27, 28 and 31 is/are allowed.
- 6) ☒ Claim(s) 22-26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 03/26/09. Accordingly, claims 2-11, 16, 19, 20 and 22-31 are currently pending; and claims 1, 12-15, 17, 18, 21 and 32 are canceled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 22-26, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

-Claims 22, 23 and 29 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101. must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Process' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter ***nor positively tie to another statutory category that accomplishes the claimed method steps***, and therefore do not qualify as a statutory process

The specific link to the Processes memo is
http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_101_05_15_2008.pdf

Claim 22 claims a method comprising steps "providing a first signal...", "providing a second digital signal...", "predistorting...", "generating an analog signal...", processing the analog signal..." and so on. These steps do not positively tie to another statutory category, e.g. an electronic device, an electronic components, etc., that accomplishes the steps. The claimed steps are of sufficient breadth that it would be reasonably interpreted as steps completely performed mentally, verbally or without machine. In fact, in light of specification, page 19, lines 23-31, of instant application, these steps can be merely implemented with software, being non-statutory.

Similarly, claim 23 claims a method comprising steps "providing a first signal...", "providing a second digital signal...", "predistorting...", "generating an analog signal...", processing the analog signal..." and so on. These steps do not positively tie to another statutory

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category, e.g. an electronic device, an electronic components, etc., that accomplishes the steps. The claimed steps are of sufficient breadth that it would be reasonably interpreted as steps completely performed mentally, verbally or without machine. In fact, in light of specification, page 19, lines 23-31, of instant application, these steps can be merely implemented with software, being non- statutory.

Similarly, claim 29 claims a method comprising steps “providing a first signal...”, “providing a second digital signal...”, “predistorting...”, “generating an analog signal...”, “processing the analog signal...” and so on. These steps do not positively tie to another statutory category, e.g. an electronic device, an electronic components, etc., that accomplishes the steps. The claimed steps are of sufficient breadth that it would be reasonably interpreted as steps completely performed mentally, verbally or without machine. In fact, in light of specification, page 19, lines 23-31, of instant application, these steps can be merely implemented with software, being non- statutory.

-Claims 24, 25, 26 and 30 are directed to an embodiment comprising “means for producing a digital input”, “means for predistorting...”, “means for converting...”, “means for generating...”, “means for analyzing...” and so on, which, in light of specification page 19, lines 23-31, of instant application, can be referred merely to software. In another word, claims 24, 25, 26 and 30 are directed to entirely a software embodiment, being a non-statutory subject matter.

Allowable Subject Matter

4. Claims 2-11, 16, 19, 20, 27, 28 and 31 are allowed.

Response to Arguments

5. Applicant's arguments filed on 03/26/09 have been fully considered.

As results, claims 2-11, 16, 19, 20, 27, 28 and 31 are indicated allowable set forth above.

Claims 22-26, 29 and 30, however, upon reconsideration, are deemed not allowable because of reasons set forth above in this Office Action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Phu whose telephone number is 571-272-3009. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chieh Fan can be reached on 571-272-3042. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuong Phu
Primary Examiner
Art Unit 2611

/Phuong Phu/
Primary Examiner, Art Unit 2611